



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,621	07/30/2003	Gregoire Verrier	NV7	9044

545 7590 07/29/2005

ANTHONY H. HANDAL
KIRKPATRICK & LOCKHART NICHOLSON GRAHAM LLP
599 LEXINGTON AVENUE
33RD FLOOR
NEW YORK, NY 10022-6030

EXAMINER

HANNAHER, CONSTANTINE

ART UNIT	PAPER NUMBER
----------	--------------

2878

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/630,621

Applicant(s)

VERRIER ET AL.

Examiner

Constantine Hannaher

Art Unit

2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20040816</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. The application data sheet submitted July 30, 2003 and the signed declaration submitted January 2, 2004 are in error in identifying the grandfather application.

Information Disclosure Statement

2. As set forth in MPEP § 609:

37 CFR 1.98(b) requires that each item of information in an IDS be identified properly. U.S. patents must be identified by the inventor, patent number, and issue date. U.S. patent application publications must be identified by the applicant, patent application publication number, and publication date. U.S. applications must be identified by the inventor, the eight digit application number (the two digit series code and the six digit serial number), and the filing date. If a U.S. application being listed in an IDS has been issued as a patent, the applicant should list the patent in the IDS instead of the application. Each foreign patent or published foreign patent application must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application. Each publication must be identified by publisher, author (if any), title, relevant pages of the publication, date and place of publication. The date of publication supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue. The place of publication refers to the name of the journal, magazine, or other publication in which the information being submitted was published.

Note the failure to identify the appropriate document number of the published foreign patent application. Note the failure to identify the inventor of the U.S. applications. Note the failure to provide a month for one or more publications. Note the failure to provide even a year for a publication. Note the failure to provide any data at all for a "brochure".

Drawings

3. The drawings were received on January 2, 2004. These drawings are acceptable.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "523" has been used to designate both the tripod and its handle (Fig. 12). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities: page 15, line 2, a spurious mark of interrogation; page 18, line 19, this parenthesis is never closed.

Appropriate correction is required.

Claim Objections

6. Claim 1 is objected to because of the following informalities: this claim ends in a semi-colon rather than a period. Appropriate correction is required.

7. Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The requirements for ultraviolet light transmission, ultraviolet light sensitivity, and focusability are inherent in the limitations of claim 1.

8. Claim 22 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The requirement for a narrower bottom is already found in claim 20.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 19, 25, and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not describe film coupled to receive a focused light image *from itself* as plainly called for by claim 19. The specification does not describe a lens of variable focal length in which the focal length is varied by an automated system as called for by claim 25, more specifically, by an electronic zoom without moving parts as called for by claim 26. As the specification makes plain at page 9, lines 1-2, the automated system is an alternative which relies upon a lens of fixed focal length.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 13, 14, 28-30, and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the limitation “said image intensifier” in line 2 (actual count). There is insufficient antecedent basis for this limitation in the claim. Claims 2 and 5 establish an image intensifier, but claim 1 plainly does not.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 28 recites the broad recitation ultraviolet-transmissive, and the claim also recites quartz which is the narrower statement of the range/limitation.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note

also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 30 recites the broad recitation ultraviolet-reflective surface, and the claim also recites a surface reflecting ultraviolet light at wavelengths from about 200 [nm] to about 360 nm which is the narrower statement of the range/limitation.

The meaning of "a method as in claim 19, further comprising:" in lines 5-6 (actual count) is not at all apparent. Claim 19 plainly does not recite a method.

The balance of the claims is rejected on the basis of their dependence.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 1, 2, 11, 5, 7, 13, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forsyth (US005886344A) in view of Lowenthal (US003517979A).

With respect to independent claim 1, Forsyth discloses (Fig.) a forensic viewer **100** comprising a lens **102**, an imaging device **103**, and support structure (column 2, lines 60-63). The lens **102** in the viewer of Forsyth is focusable (column 3, lines 32-33) and comprises a plurality of optical elements (column 3, lines 15-16) which transmit ultraviolet light (column 3, lines 6-8) and while "other focal lengths" are desired (column 3, line 33) the illustrated lens **102** is not of variable focal length. Lowenthal shows (Fig.) that a focusable lens with a plurality of optical elements **R** which transmit ultraviolet light (column 1, lines 50-55) can have a variable focal length (column 1, lines 28-32). In view of the desirable single lens suggested by Lowenthal for the other focal lengths sought by Forsyth, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the lens **102** of Forsyth to have a variable focal length.

With respect to dependent claim 2, the imaging device **103** in the viewer **100** of Forsyth is an electrically powered image intensifier (column 3, lines 45-65).

With respect to dependent claim 11, the nature of the mounting structure between lens **102** and any support structure in the viewer **100** of Forsyth is a choice within the ordinary skill in the art at the time the invention was made in view of the variety available of suitable performance.

With respect to dependent claim 5, the UV image intensifier **103** in the viewer **100** of Forsyth is of the recited type.

With respect to dependent claim 7, Forsyth discloses a tripod mounting (column 2, line 64).

With respect to dependent claim 13, the viewer **100** of Forsyth further comprises viewing optics **105** of the type recited (column 4, lines 16-20).

With respect to dependent claim 14, the viewer **100** of Forsyth further comprises viewing optics for presenting the output of the image intensifier to a camera (column 6, lines 28-32).

Although Forsyth describes the use of an electronic image detector, the use of a photographic film

camera would have been obvious to one of ordinary skill in the art for archival purposes and the like.

With respect to dependent claim 16, the viewer **100** of Forsyth further comprises an ultraviolet filter **101** in the recited position.

16. Claims 3, 4, 9, 10, 12, 15, 17, 19, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forsyth (US005886344A) and Lowenthal (US003517979A) as applied to claim 2 above, and further in view of Nagano *et al.* (US005012264A).

With respect to dependent claim 3, the lens **102** in the viewer **100** of Forsyth may be presumed to further comprise a mounting structure thereon in view of the maintenance of “correct mechanical spacings” by the housing enclosure (column 4, lines 20-24) which otherwise constitutes a chassis of the recited type. The viewer **100** also comprises a power source (column 3, line 58).

Nagano *et al.* shows (Fig. 1) that in a viewer comprising a lens **2**, mounting structure **16**, an electrically powered accessory **L** (as supplied with power from contact **5a**), a power source **7**, and a chassis **1**, the presence of an electrical switch **T₂** having an open state and a closed state, connected to couple electrical power from power source **7** to power output terminal **5a** in the closed state and to decouple electrical power from power source **7** to power output terminal **5a** in the open state, and the electrical switch **T₂** further comprising (Fig. 2) an operator **12** for configuring the electrical switch **T₂** in the open state in an open operator position or in a closed state in a closed operator position, and the operator **12** being urged into the closed operator position by the lens **2** mounted on the chassis **1** in the use position (lock pin **P** under the influence of spring **10** is able to urge operator **12** into its closed position only when the lens **2** and its mounting structure **16** are fully in the “attached” state with chassis **1**) is known. Since it is apparent that the viewer **100** of Forsyth is not useful without the lens **102** attached (at least because the unfocused light reaching intensifier **103**

cannot be “imaged”) and in view of the security of delivering electrical power to an accessory only when the lens is securely attached as described by Nagano *et al.*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the viewer **100** to comprise an electrical switch of the type suggested by Nagano *et al.* such that electrical power was coupled to the image intensifier **103** only when lens **102** was attached.

With respect to dependent claim 4, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make lens **102** in the viewer **100** of Forsyth moveable in the manner recited (a standard feature of interchangeable lens systems for decades) in order to achieve the desired alternative embodiments (column 3, lines 33-36). The claim requirement that movement of the lens into the use position causes the operator to assume the closed operator position is suggested by Nagano *et al.*

With respect to dependent claim 9, the nature of the mounting structure between lens **102** and any support structure in the viewer **100** of Forsyth is a choice within the ordinary skill in the art at the time the invention was made in view of the variety available of suitable performance.

With respect to dependent claim 10, the lens **102** in the viewer **100** of Forsyth transmits ultraviolet light and the electrically powered image intensifier **103** is sensitive to ultraviolet light and the lens is focusable.

With respect to dependent claim 12, the viewer **100** of Forsyth further comprises viewing optics **105** for the purpose recited.

With respect to dependent claim 15, the operator **12** suggested by Nagano *et al.* is biased by a spring **13** in the open operator position (retracted from switch **T₂**).

With respect to dependent claim 17, the viewer **100** of Forsyth further comprises an ultraviolet filter **101** in the recited location.

With respect to dependent claim 19, as best understood, the viewer **100** of Forsyth further comprises a camera (column 6, lines 28-30). Although Forsyth describes the use of an electronic image detector, the use of a photographic film camera would have been obvious to one of ordinary skill in the art for archival purposes and the like.

With respect to dependent claim 18, the viewer **100** of Forsyth comprises an eyepiece **105** coupled to the intensifier **103**.

17. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forsyth (US005886344A), Lowenthal (US003517979A) and Nagano *et al.* (US005012264A) as applied to claim 3 above, and further in view of Vezard (US005581356A).

With respect to dependent claim 24, an ultraviolet light source is known as shown at **10** (Fig. **1**) in Vezard. Although the viewer **100** of Forsyth is normally used to image emissions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the viewer **100** to further comprise an ultraviolet light source mounted on support structure (the enclosing housing) in view of the opportunity to use the hand-held ultraviolet light image intensifying viewer suggested by the combination of Forsyth, Lowenthal, and Nagano *et al.* in situations which do not include emissions as suggested by the forensic light source of Vezard.

18. Claims 6 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forsyth (US005886344A) and Lowenthal (US003517979A) as applied to claim 1 above, and further in view of Vezard (US005581356A).

With respect to dependent claims 6 and 23, an ultraviolet light source is known as shown at **10** (Fig. **1**) in Vezard. Although the viewer **100** of Forsyth is normally used to image emissions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the viewer **100** to further comprise an ultraviolet light source mounted on support structure

(the enclosing housing) in view of the opportunity to use the hand-held ultraviolet light image intensifying viewer suggested by the combination of Forsyth and Lowenthal in situations which do not include emissions as suggested by the forensic light source of Vezard.

19. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forsyth (US005886344A) and Lowenthal (US003517979A) as applied to claim 1 above, and further in view of Rosett (US002401191A).

With respect to dependent claim 8, the imaging device **103** in the viewer **100** of Forsyth is a layer of material which converts ultraviolet light to electrons (photocathode) but a layer of material which converts ultraviolet light to visible light has long been known, however, as shown at **12** in Rosett, and it would have been obvious to one of ordinary skill in the art to modify the viewer **100** suggested by Forsyth and Lowenthal to include such a layer in imaging device **103** in order to use image intensifiers which employ a photocathode sensitive to visible light as these are more common and thus less costly.

20. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forsyth (US005886344A) and Lowenthal (US003517979A) as applied to claim 1 above, and further in view of Reddig *et al.* (US00D316556S).

With respect to dependent claim 20, the support structure and enclosing housing disclosed by Forsyth has none of the recited features. Nevertheless, a viewer wherein the chassis comprises a housing with a round top and narrowed bottom and further comprising specifically a hand strap coupled at specifically two points to the side of the housing is known from Reddig *et al.* (Fig. 1). Since the configuration of Forsyth is left as a choice to one within the ordinary skill in the art in view of the schematic view, it would have been obvious to package the necessary elements of lens, image intensifier, and power source, with any necessary mirrors and lenses in a housing of the form

suggested by Reddig *et al.* in view of the compact configuration achieved thereby. The hand strap adds comfort and security to holding the viewer.

With respect to dependent claim 21, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the round top of the housing suggested by Reddig *et al.*, rendered in the views as a textured portion, was made of a soft grippable material in view of the inviting hold and improved security provided thereby. Retention of a soft grippable material specifically at the top of the housing in modifying the forensic viewer suggested by Forsyth and Lowenthal would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the desire not to let the expensive, delicate instrument fall out of the grasp of the user.

With respect to dependent claim 22, to the extent the recitation further limits that of claim 20, the housing suggested by Reddig *et al.* is narrower at the “bottom” of the housing as compared to the “top” of the housing, as is best appreciated from Fig. 2.

21. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forsyth (US005886344A) and Lowenthal (US003517979A) as applied to claim 1 above, and further in view of Dirscherl *et al.* (US005001348A).

With respect to dependent claim 25, as best understood, while the variable focal length lens suggested by Lowenthal may be taken to represent a manual zoom, the employment of a lens in which the focal length is varied by an automated system is shown by Dirscherl *et al.* (Fig. 5B with lens 1 and electro-optical zoom 60). In view of the ability to depict any portion of the field of view centrally as suggested by Dirscherl *et al.*, thus achieving the other focal lengths desired by Forsyth without manipulation of any optics, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the viewer 100 of Forsyth, whether modified by the

With respect to dependent claims 2 and 3, these recitations are anticipated by the recitations of the application claim 1.

With respect to dependent claim 4, the recitations are anticipated by the recitations of the application claim 2.

With respect to dependent claim 9, the recitations are anticipated by the recitations of the application claim 4.

With respect to dependent claim 10, the recitations are anticipated by the recitations of the application claim 3.

With respect to dependent claim 12, the recitations are anticipated by the recitations of the application claim 6.

With respect to dependent claim 15, the recitations are anticipated by the recitations of the application claim 8.

With respect to dependent claim 17, the recitations are anticipated by the recitations of the application claim 10.

With respect to dependent claim 19, the recitations are anticipated by the recitations of the application claim 12.

With respect to dependent claim 18, the recitations are anticipated by the recitations of the application claim 11.

With respect to dependent claim 11, the recitations are anticipated by the recitations of the application claim 5.

With respect to dependent claim 5, the recitations are anticipated by the recitations of the application claim 3.

suggestion of Lowenthal or not, to include an automated system for changing the focal length of the lens 102.

With respect to dependent claim 26, the automated system 60 suggested by Dirscherl *et al.* is of the recited type (Fig. 5A).

Double Patenting

22. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

23. Claims 1-4, 9, 10, 12, 15, 17, 19, 18, 11, 5, 7, 13, 14, 16, and 20-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 10-12, and 14-16 of copending Application No. 10/209,439 (published as US2004/0021086A1) in view of Yoshida *et al.* (US005691854A).

This is a provisional obviousness-type double patenting rejection.

With respect to independent claim 1, the recitations are anticipated by the recitations of the application claim 1 but for the requirement that the camera lens be of “variable focal length.” That a lens which is useful for imaging ultraviolet light may have a variable focal length is known from Yoshida *et al.* (column 5, lines 49-54). It would have been obvious to one of ordinary skill in the art to modify the claim to recite a variable focal length lens so as to achieve a difference in claim scope.

With respect to dependent claim 7, a tripod mounting for an imager is so well known as to require no citation. It would have been obvious to one of ordinary skill in the art to modify the claim to recite a tripod mounting so as to achieve a difference in claim scope.

With respect to dependent claim 13, the recitations are anticipated by the recitations of the application claim 6.

With respect to dependent claim 14, the recitations are anticipated by the recitations of the application claim 7.

With respect to dependent claim 16, the recitations are anticipated by the recitations of the application claim 10.

With respect to dependent claim 20-22, the recitations are anticipated by the recitations of the application claims 14-16.

24. Claim 8 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/209,439 (published as US2004/0021086A1) in view of Yoshida *et al.* (US005691854A) and Rosett (US002401191A).

This is a provisional obviousness-type double patenting rejection.

With respect to dependent claim 8, the recitations are made obvious by the combination with Yoshida *et al.* as explained in the rejection of claim 1 but for the requirement that the imaging device be a layer of material which converts ultraviolet light to visible light. Such a layer has long been known, however, as shown at 12 in Rosett, and it would have been obvious to one of ordinary skill in the art to modify the claim to recite such a layer so as to achieve a difference in claim scope.

25. Claims 27-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 6, 10-12, 14-16, 18, and 19 of U.S. Patent No. 6,392,238 in view of Yoshida *et al.* (US005691854A).

With respect to independent claim 27, the recitations are anticipated by the recitations of the patent claim 1 but for the requirement that the camera lens be of "variable focal length." That a lens which is useful for imaging ultraviolet light may have a variable focal length is known from Yoshida *et al.* (column 5, lines 49-54). It would have been obvious to one of ordinary skill in the art to modify the claim to recite a variable focal length lens so as to achieve a difference in claim scope.

With respect to dependent claim 28, the limitations of this claim are identical to those of the patent claim 2.

With respect to dependent claim 29, a tripod mounting for an imager is so well known as to require no citation. It would have been obvious to one of ordinary skill in the art to modify the claim to recite a tripod mounting so as to achieve a difference in claim scope.

With respect to dependent claim 30, the limitations of this claim are identical to those of the patent claim 6.

With respect to dependent claim 31, the limitations of this claim are identical to those of the patent claim 10.

With respect to dependent claim 32, the limitations of this claim are identical to those of the patent claim 11.

With respect to dependent claim 33, the limitations of this claim are identical to those of the patent claim 12.

With respect to dependent claim 34, the limitations of this claim are identical to those of the patent claim 14.

With respect to dependent claim 35, the limitations of this claim are identical to those of the patent claim 15.

With respect to independent claim 36, the recitations are anticipated by the recitations of the patent claim 16 but for the requirement that the camera lens be of “variable focal length.” That a lens which is useful for imaging ultraviolet light may have a variable focal length is known from Yoshida *et al.* (column 5, lines 49-54). It would have been obvious to one of ordinary skill in the art to modify the claim to recite a variable focal length lens so as to achieve a difference in claim scope.

With respect to independent claim 37, the recitations are anticipated by the recitations of the patent claim 18 but for the requirement that the camera lens be of “variable focal length.” That a lens which is useful for imaging ultraviolet light may have a variable focal length is known from Yoshida *et al.* (column 5, lines 49-54). It would have been obvious to one of ordinary skill in the art to modify the claim to recite a variable focal length lens so as to achieve a difference in claim scope.

With respect to independent claim 38, the recitations are anticipated by the recitations of the patent claim 19 but for the requirements of a “crime scene” and the use and adjustment of a camera lens of “adjustable focal length.” That a lens which is useful for imaging ultraviolet light may have a adjustable focal length is known from Yoshida *et al.* (column 5, lines 49-54). It would have been obvious to one of ordinary skill in the art to modify the claim to recite the use and adjustment of a adjustable focal length lens so as to achieve a difference in claim scope. The performance of ultraviolet light photography as recited in the patent claim 19 encompasses the scope of “examining a crime scene” as recited.

Response to Submission(s)

26. This application has been published as US2004/0099809A1 on May 27, 2004.

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Oba *et al.* (JP 60-17325 A) and Suzuki *et al.* (JP 59-221946 A) disclose ultraviolet light viewers.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Constantine Hannaher whose telephone number is (571) 272-2437. The examiner can normally be reached on Monday-Friday with flexible hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Porta can be reached on (571) 272-2444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ch


Constantine Hannaher
Primary Examiner